

REMARKS

In response to the above-identified final Office Action, Applicants amend the application and seek reconsideration thereof. In this response, Applicants amend Claim 1. Accordingly, Claims 1, 3, and 9-14 are pending.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attachment is captioned "Version With Markings To Show Changes Made."

In the Office Action mailed February 27, 2003, the Examiner rejected Claims 1, 3, and 9 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. To the extent the rejection applies to the amended claims, Applicants respectfully traverse the rejection.

Applicants respectfully submit that independent Claim 1 has been amended to overcome the rejection. Applicants respectfully request that the Examiner withdraw the rejection to Claims 1, 3, and 9.

In the Office Action, the Examiner rejected Claims 1, 3, and 9 under 35 U.S.C. § 102(b) as being anticipated by Li (WO97/49136) ("Li"). To the extent that the rejection applies to the amended claims, Applicants respectfully traverse the rejection. Applicant respectfully submits that Li teaches, "alkali metal-mixed transition metal oxide core. . . (or) . . . a lithiated transition metal oxide, or mixed transition metal oxide." (Li, page 5, lines 9-12.) Li also teaches, "the most preferred core compositions would comprise lithium nickel dioxide, or a lithium nickel cobalt dioxide having the formula $\text{LiNi}_{1-y}\text{Co}_y\text{O}_2$." (Li, page 6, lines 4-6.)

Applicants respectfully submit that Claim 1 recites the limitation of a positive active material compound that has the formula $\text{Li}_a\text{Ni}_{1-x-y}\text{Co}_x\text{M}_y\text{O}_2$. Applicants respectfully submit that the Examiner has not pointed out where Li teaches or suggests a positive active material compound with the specific formula as recited in Applicants' Claim 1. For at least the reasons stated above, Applicants respectfully submit that Li does not anticipate Applicants' independent Claim 1 and dependent Claims 3 and 9. Applicants respectfully request that the Examiner withdraw the rejection to Claims 1, 3, and 9.

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In the Office Action, the Examiner rejected Claims 1, 3, and 9 under 35 U.S.C. § 102(e) as being anticipated by Kweon et al. (U.S. Patent No. 6,372,385) ("Kweon"). To the extent that the rejection applies to the amended claims, Applicants respectfully traverse the rejection. Applicants respectfully submit that the specification has been amended so that the above-captioned application is a Continuation-In-Part of co-pending U.S. Application Serial No. 10/041,921, which in turn is a Continuation of U.S. Application Serial No. 09/248,202, which issued into Kweon.

MPEP §201.11 sets forth the requirements for claiming continuity between applications. 35 U.S.C. §120 states that an application can have the benefit of a prior filed application, "if it contains or is amended to contain a specific reference to the earlier filed applications." Applicants respectfully submit that the above-captioned application is hereby being amended to contain a reference to the earlier filed applications pursuant to 35 U.S.C. §120.

Applicants respectfully submit that the above-captioned application is co-pending with Application No. 10/041,921, which in turn was co-pending with Application No. 09/248,202. Applicants respectfully submit that a proper reference to these applications is being added by this amendment. Applicants respectfully submit that the above-captioned application claiming benefit to the earlier filing dates is being claimed by an inventor of the above-captioned application, who is also named in the previously filed applications.

Applicants respectfully submit that the new time period requirements under 37 CFR §1.78(a)(2) and (a)5 are only applicable to utility or plant applications filed on or after November 29, 2000. Since the above-captioned application was filed June 16, 2000, the new time period requirements are not applicable.

Accordingly, Applicants respectfully submit that Kweon is not prior art to the above-captioned application. Applicants respectfully request that the Examiner withdraw the rejection to Claims 1, 3, and 9.

In the Office Action, the Examiner rejected Claims 10 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Miyasaka (U.S. Patent No. 6,037,095) ("Miyasaka") in view of Nishida et al. (Japanese Patent Abstract Publication No. 08-236114) ("Nishida"). Applicants respectfully traverse the rejection.

As the Examiner noted in the Office Action, "Miyasaka does not explicitly state the positive active material is coated with a metal oxide." In addition, Applicants respectfully submit that Miyasaka does not implicitly state the positive active material is coated with a metal oxide, or suggest the desirability of coating the positive active material with metal oxide.

Miyasaka teaches that the surface of the positive active electrode material can be modified, and gives examples of treating within an esterifying agent or chelating agent, coating with an electro-conductive polymer or polyethylene oxide, or coating with an iron-conductive polymer or a poly-acetylene layer, or treated with a lithium salt (Miyasaka, col. 10, lines 48-56). Applicants respectfully submit that Miyasaka does not teach or suggest the desirability of coating the positive active material with a metal oxide, in general, nor does Miyasaka teach or suggest the desirability of coating with the particular metal oxides as recited in Applicants' Claims 10 and 11.

Applicants respectfully submit that Nishida does not remedy the defects of Miyasaka. Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness since there is no suggestion or motivation to modify the reference or to combine the reference teachings. (MPEP § 2142.) Applicants respectfully submit that the Examiner is utilizing impermissible hindsight to remedy the defects of Miyasaka with the teachings of Nishida.

In the Office Action mailed February 27, 2003, the Examiner stated that, "It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning." Applicants respectfully disagree.

The C.A.F.C. in the case of In re Ochiai held that, "When the references cited by the Examiner fail to establish a *prima facie* case of obviousness, the rejection is improper and will be overturned." (In re Ochiai, 71 F.3d 1565 at 1569, Fed.Cir. 1995.)

The Federal Circuit has disallowed the use of hindsight on numerous occasions, "in so erring, the Board impermissibly used hindsight to arrive at the claimed invention." (In re Zurko, 111 F.3d 887 at 889, Fed. Cir. 1997) "In determining obviousness, the invention must be continued as a whole without the benefit of hindsight, and the claims must be considered in their entirety." (Rockwell Intern. Corp. v. U.S., 147 F.3d 1358 at 1364, Fed. Cir. 1998) "Close adherence to this methodology is especially important in cases where the very ease with which the invention can be

understood may prompt one to fall victim to the insidious effect of a hindsight syndrome." (*In re Kotzab*, 217 F.3rd 1365 at 1369, Fed. Cir. 2000)

For at least the reasons stated above, Applicants respectfully request that the Examiner withdraw the rejection to Claims 10 and 11.

In the Office Action, the Examiner rejected Claims 10 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Miyasaka in view of Kweon.

Applicants respectfully submit that Kweon is not prior art to the above-captioned application, as discussed above. Applicants respectfully request that the Examiner withdraw the rejection to Claims 10 and 11.

In the Office Action, the Examiner allowed Claims 12-14. Applicants would like to thank the Examiner for allowing Claims 12-14.

CONCLUSION

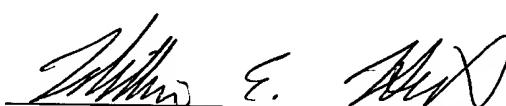
In view of the foregoing, it is believed that all claims now pending patentably define the subject invention over the prior art of record and are in condition for allowance and such action is earnestly solicited at the earliest possible date.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly, extension of time fees.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

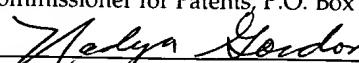
Dated: 5/27/03



William E. Hickman, Reg. No. 46,771

CERTIFICATE OF MAILING:

I hereby certify that this correspondence is being deposited on the date shown below as First Class Mail with sufficient postage with the United States Postal Service in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



Nadya Gordon 5/27/03 Date

12400 Wilshire Blvd.
Seventh Floor
Los Angeles, California 90025
(310) 207-3800

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE SPECIFICATION

Paragraph 1 on page 1, beginning on line 4, was amended as follows:

This application is a Continuation-In-Part of U.S. Application No. 10/041,921, filed January 7, 2002; which is a Continuation of U.S. Application No. 09/248,202, filed February 10, 1999 (now U.S. Patent No. 6,372,385); as prior applications for which the pending application claims the benefit. This application is based on application No. 99-22765, filed in the Korean Industrial Property Office on June 17, 1999, the content of which is incorporated hereinto by reference.

IN THE CLAIMS

Claim 1 is amended as follows:

1. (Three Times Amended) A positive active material for a lithium secondary battery of which the surface is coated with a metal oxide, wherein the positive active material compound comprises $Li_aNi_{1-x-y}Co_xM_yO_2$ and M is a metal selected from the group consisting of Al, Mg, Sr, La, Ce, V, and Ti, and $0 \leq x < 0.99$, $0.01 \leq y \leq 0.1$, and $1.00 \leq a \leq 1.1$, wherein the metal oxide coated on the surface of the compound is an oxide of a metal selected from the group consisting of Mg, Ti, Al, V, Co, K, Ca, Na, and B.